UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/858,043	05/15/2001	Junichi Kurihara	112857-236	1337

29175 7590 05/16/2005

BELL, BOYD & LLOYD, LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
LEZAK, ARRIENNE M	
ART UNIT	**PAPER NUMBER**
2143	

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/858,043	KURIHARA ET AL.	
	Examiner	Art Unit	
	Arrienne M. Lezak	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-5 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-5 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Examiner notes that no Claims have been amended, no Claims have been cancelled and Claims 3-5 have been added. Claims not explicitly addressed herein are found to be addressed within prior Office Action dated 12 November 2004 as reiterated herein below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over complete consideration of US Patent US 6,219,694 B1 to Lazaridis.

3. Regarding Original Claim 1 and New Claim 3, Lazaridis discloses a content delivering method for transmitting a content file from a server to a user terminal unit through a network, (Abstract & Fig. 1), and for causing the user terminal unit to stream-reproduce, (multimedia), the content file, (Col. 2, lines 48-67; Cols. 3-4; & Col. 6, lines 20-22), the method comprising the steps of:

- designating a non-skip area that represents an important portion to the content file, (Col. 2, lines 61-65 – user-defined event triggers);

- storing information associated with the non-skip area in a database, (Fig. 3 & Col. 3, lines 7-8);
- transmitting information from the non-skip area from the server to the user terminal unit along with the content file, (Col. 2, lines 48-67 & Cols. 3-4);
- causing the user terminal unit to determine whether or not the non-skip area has been skipped and when the non-skip area has been skipped, transmitting information indicating that the non-skip area has been skipped to the server, (Col. 2, lines 48-67 & Cols. 3-4); and
- causing the server to transmit information corresponding to the non-skip area from the database to the user by another transmitting means when the server receives the information indicating that the non-skip area has been skipped, (Col. 2, lines 48-67 & Cols. 3-4).

4. Examiner finds that Lazaridis discloses a method incorporating an event-driven redirector/repackaging computer program capable of designating user-defined triggering events, which events, (to one of ordinary skill in the art at the time of invention by Applicant), would obviously include designation of code/data (a non-skip area) for purposes of triggering redirection. Further, it is noted that the triggering event in Lazaridis would obviously cause the chain of events claimed by Applicant. Specifically, in view of Lazaridis, it would be obvious for the completion of any predetermined triggering event to cause the host to make a determination and perform a subsequent action (redirection of designated portion of data). Moreover, Examiner notes that Lazaridis discloses video and audio clip attachments, which attachments obviously

utilize streaming media methods. Thus, Original Claim 1 and New Claim 3 are found to be unpatentable in view of the teachings of Lazaridis.

5. Regarding Original Claim 2 and New Claim 4, Lazaridis discloses a content delivering method for transmitting a content file wherein the other transmitting means is electronic mail, (Col. 2, lines 48-67 & Cols. 3-4). Thus, Original Claim 2 and New Claim 4 are found to be unpatentable in view of the teachings of Lazaridis.

6. Regarding New Claim 5, Lazaridis discloses wherein the information associated with the non-skip area includes at least one of: user information, file ID, non-skip area data and content creator information, (Col. 4, lines 50-67). Thus, New Claim 5 is found to be unpatentable in view of the teachings of Lazaridis.

Response to Arguments

7. Applicant's arguments filed 21 January 2005, have been fully considered but they are not persuasive. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the mobile device designates a "non-skip" area) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from

the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Specifically, Examiner notes that the claims, as written, do not delegate the "designation" responsibility to anyone in particular, and as such, either the user or the host may designate. Since Lizaridis clearly teaches a user designation, Examiner notes that Lizaridis clearly reads upon Applicant's claim language as written. Additionally, Examiner notes that Applicant's specification is silent as to the host system designating the "non-skip" area, as it appears to be the user who enters into a contract with the content management company indicating which content the user would like designated for download.

9. Thus, as Examiner has completely addressed Applicant's amendment, and finding Applicant's arguments do not show how the amendments and reconsideration of the same avoids such references or objections, Examiner hereby rejects all original and newly added claims in their entirety as noted herein above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arrienne M. Lezak whose telephone number is (571)-272-3916. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571)-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arrienne M. Lezak
Examiner
Art Unit 2143

AML

BUNJOB JAROENCHONWANIT
PRIMARY EXAMINER